

## REMARKS

With entry of the foregoing Amendment Claims 3-28 and 34-91 are now in the application. New Claims 56-91 are now added for the first time. No claim has yet been allowed.

The Office Action rejected Claim 1 under 35 U.S.C. § 112, with the Examiner stating that the recitation of "said system" in line 1 of Claim 1 lacked antecedent basis. However, Claim 1 has previously been withdrawn from the application.

Applicants have noted however that there may be a possible problem with the language of Claims 24-28, which depend from Claim 23. -Claim 23 is a method claim whereas Claims 24-28 recited only "system" elements. Claims 24-28 are now rewritten to make it clear that they are intended as method claims.

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,850,007 ("Marino") in view of U.S. Patent 6,614,896 ("Rao"). -Applicants respectfully traverse this rejection, especially in light of the amendments now made to Claim 23.

The Examiner was of the opinion that Marino teaches the claimed limitations of (a) having a user request directory assistance for a selected number and then (b) the system using that request to automatically select an advertisement from an advertising database.

Marino discloses a system for providing economical telephone toll service in which a telephone subscriber selects the toll service by sending a signal, dialing a directory assistance call or a telephone toll call. After the caller's options are determined, and typically before signaling for the call is commenced, a recorded announcement is connected to the subscriber's line, the announcement consisting of at least one advertisement. (See the Abstract of Marino).

The first section of Marino references by the Examiner (column 1, lines 44-55 of Marino) describes merely that an advertisement is selected from a data bank according to "some predetermined technique" which may include "any number of factors or features. No further details of the method for how the advertisement is selected are stated in that section.

Column 2, lines 4-8 of Marino were also referenced by the Examiner. However, that section states merely that the provided telephone toll service differs from telephone shopping

services in that the caller is not looking for the specific information contained in the advertisements indeed he is seeking to place a personal long distance call. It is stated also that the advertisement selection technique is adapted to pick advertisements suited to "his general (sic) interest." (Marino, Col. 2, line 12).

It is also stated at column 4, lines 21-35 of Marino that various types of demographic information can be used to determine the advertisement. It is said that demographic information can include information that persons living in a particular location might be generally interested in certain topics. Locations can be associated with a central office code contained in the ANI or central office code of the caller, or from the central office code of the called party.

Later on in Marino, beginning at column 4, line 57, -one example is discussed for how a set of advertisements is chosen. The announcements are said to be chosen on a random basis, or to provide sufficient exposure to each of the advertisers who provided ads for the service. There is still no mention even to this point in Marino of a selection technique that would select an advertisement based on a user's directory assistance request. -The user interest is apparently determined (Marino, Col. 5, lines 1-12) by having the caller participating in the service by an appropriate check-off on his monthly bill which of several general categories of subjects he is interested in; or in a separate profile card that is filled out by the caller.

It is clear, then, that a system as described in Marino does not select the advertisement based on the content of the request for directory assistance itself. We believe that this distinction is now more particularly pointed out in Applicant's claim 23 which as amended now states:

... requesting directory assistance for a selected number by a user, the selected number being associated with a specific provider of goods or services, using the selected number for the specific provider of goods or services to automatically select a selected advertisement from an advertising database.

The Applicant's claim thus requires using the selected number (telephone number) associated with a specific provider of goods or services to determine which advertisement to select.

At best, Marino only suggests selecting advertisements determined from surveys previously filled out by the caller, or demographic information intended to determine general subject matters of interest to the caller, or at random. Marino does not disclose or suggest using a selected number, for a specific provider of goods or services to select an advertisement.

We must also disagree with the Examiner's interpretation of Rao. The Examiner was of the belief that Rao teaches the claimed steps of asking a user if they wish to be connected to an advertised provider specified in an advertisement.

Rao, at column 3, lines 15-20, describes that a busy announcement is transmitted to a caller when a dialed number (DN) is busy. When the busy announcement is transmitted to the caller the caller is asked if they wish to listen to advertisements. The caller is automatically connected to the busy DN when the called DN becomes free. Thus, while the caller is connected to an advertisement server, so that they may hear an advertisement while the called line is busy.

As now amended, Applicant's claim 23 specifically requires:

presenting the selected advertisement to said user, [and] asking said user if they want to be connected to an advertised provider associated with said selected advertisement.

Since there is no suggestion in Rao to connect the caller to the advertiser's provider's telephone, these claim elements are also not found in the prior art.

Therefore, even if Marino were combined with Rao the resulting method would fail to teach all of the elements recited in Claim 23. Thus, there is no prima facie case of obviousness of Claim 23.

We furthermore note that there would be little motivation to combine Marino and Rao as the Examiner suggests, absent the Applicant's teachings. The Applicant's invention is concerned with providing free (no cost)- directory assistance which is accessed toll free. Marino is concerned with techniques for providing toll call services. Rao is concerned with playing advertisements when a busy signal is received. Rao does not contemplate arrangements for handling the charges for calls whatsoever. Thus, one of skill in the art would not have been motivated to look at Marino or Rao in solving the problems which were faced by the Applicant,

namely, to provide "free" directory assistance accessed via a toll free telephone number, without using "toll" services of any kind.

Additionally, the claims that directly or indirectly depend on Claim 23, namely claims 25-28 and 86, are also not obvious over Marino in view of Rao for the same reasons.

Claim 24 was also specifically rejected under 35 U.S.C. §103 in view of Marino, Rao, and Swix (U.S. Patent 6,718,551). The Examiner was of the opinion that Swix teaches selection of advertisements based on Standard Industry Codes (SICs). However, Swix is concerned with internet advertising, a situation where only limited data is available to determine a customer profile. To collect such data the targeted internet advertising systems record user selections from previous internet activity based on standard industry codes. There is no suggesting in Swix that standard industry code be used, as set forth in Applicant's Claim 24, as part of analyzing a selected number in a request for directory assistance for a specific provider of goods or services.

Claim 24 is also otherwise patentable because of the failure of Marino and/or Rao to teach the other claim elements as described above.

Claims 34-35, 37-39, 42 and 45-54 were rejected under 35 U.S.C. § 103 as being unpatentable over Trader (U.S. Patent 5,909,670) in view of Marino.

Trader admittedly does describe a system wherein a request for information originates from a customer station, and the request for information is then analyzed. -We first note that Trader is not a directory assistance information system, as recited in Applicant's claims.

Trader is a system in which a user calls to receive advertisements for items that are listed for sale. The caller's request in Trader will always inherently specify a general category, with the system then selecting one or more ads within that category. For example, the caller contacts the Trader service and the system prompts the user to select a category for which they are looking for information, e.g., "Autos" or "Homes". -(See Trader at Col. 3 lines 42-48 and Fig. 3a, step 42). The caller then uses dialed digits to select a general category ("Autos" in the example). The system prompts the caller for further selection about auto make (e.g., "Chevrolet or Ford"). -The

system then selects advertisements within the general categories selected by the caller (Trader, Fig. 4a, step 43 et al.).

However, with Applicant's invention the consumer does not call looking for information in a general category. Instead the consumer is making a directory assistance call looking for specific information, i.e., the telephone number, of a specific provider of a good or service. Sticking with the automobile example, in Applicant's system, the caller is looking for a specific provider of automobile services, such as "Hansel Ford, in Santa Rosa, California". The request itself does not inherently specify a category. -The system then first analyzes "Hansel Ford, in Santa Rosa California" to determine a telephone number for that specific service provider, i.e., Hansel Ford. -It then uses that telephone number and/or "Hansel Ford" to determine that this request for specific information about Hansel Ford relates to the more general subject category of "automobiles" or even "Ford" automobiles. An advertisement is then selected from the devised general category for "automobiles" or "Fords".

Applicant's method as recited in Claim 34 thus requires

providing a request for information relating to a telephone number for a specific provider of goods or services; ...

examining the request for information to identify a subject matter area associated with the specific provider of goods or services.

Trader does not disclose either of the limitations above. Trader neither handles a request for a telephone number of a specific provider of goods or services, nor examine that request for a specific provider to determine a more general subject matter area. Trader works by having the caller already and inherently specify a general subject matter area.

Amended Claim 34 should thus be allowed.

Additionally, the claims that directly or indirectly depend from claim 34, namely Claims 35, 37-39, 42 and 45-54 are also not obvious over Trader in view of Marino for the same reasons.

We also note that Claim 51 furthermore requires that, in addition to playing the advertisement to the caller, that the caller be connected to the service provider specified in the original request for directory assistance information. Neither Trader nor Marino provide or suggest such for such a connection. Therefore, at least Claim 51 should be allowed.

Claims 36 and 43-44 were rejected under 35 USC 103 as being obvious in view of Trader and Marino and further in view of Gregorek (U.S. Patent 4,850,007). -These claims depend from Claim 34 and are patentable for the same reasons stated above. Gregorek does not disclose the claimed element of providing a request for information for a specific provider of goods or services, or the claimed element of examining that request to identify a subject matter area.

Finally, Claims 40-41 and 55 were rejected under 35 USC 103 as being obvious in view of Trader, Marino, and Swix. These claims are patentable for the same reasons stated above for Claim 34.

New Claims 56-91 are also Patentable

New Claim 56 depends from Claim 34 and adds an additional feature that the request for a specific provider of goods or services does not inherently determine the subject matter area. Claim 56 is allowable for the same reasons as Claim 34.

New Claims 57-62 are directed to a machine-accessible medium containing instructions the perform the functions recited for the call processing station of Claim 34. These claims are patentable for at least the same reasons as Claim 34.

New Claims 63-86 are system claims including limitations where a call processing station operates to receive a request for directory assistance information from the customer station, to examine the request for directory assistance information to identify a subject matter area associated with a specific provider of goods or services, to automatically select an advertisement categorized within the subject matter area, and to selectively forward the selected advertisement to the customer station.

New Claim 87 depends from Claim 23 and is patentable for the same reasons stated above.

New claims 88-91 are apparatus claims that include limitations where the advertisement is selected based on a toll free directory assistance request for a telephone number associated with a provider of one of goods and services, and the advertisement is targeted to one of the goods and the services.

None of the cited prior art documents disclose, teach or suggest a method, apparatus or system as claimed.

#### Request for Status of Wolmuth Declaration

A Declaration of Scott Wolmuth was filed on October 12, 2005 setting forth the details of certain acts by the inventor which occurred more than one year before the filing date of Applicant's original patent application. As explained in the Applicant's last response dated December 19, 2005, it is believed that these acts did not amount to an enabling disclosure of the claimed invention.

However, the Office Action dated June 2, 2006 neither acknowledges receipt of the Declaration nor confirms that the Examiner agrees these acts have no effect on patentability of the Applicant's claims. Consideration of the Declaration and confirmation of its effect on the claims is again respectfully requested. An Information Disclosure Statement is being filed herewith requesting this review.

**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

As the Applicants have now submitted two Replies to two different Office Actions, including a Request for Continued Examination, if the Examiner is inclined to reject the Application once again, it is requested that the Examiner first extend the courtesy of a telephone call to afford the Applicant an opportunity for a further interview to discuss this matter.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Michael J. Bachner Jr *Reg. # 51,425*  
David J. Thibodeau, Jr.  
Registration No. 31,671  
Telephone: (978) 341-0036  
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: 8/22/06